# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/776,040 | 02/01/2001 | Joerg Ehrhardt | 7057 US | 2464 |

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| EXAMINER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *19 October 2009*.
2a)☐ This action is **FINAL**.            2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-20* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

## DETAILED ACTION

1.     In view of the Order Returning Undocketd Appeal to Examiner filed on 1/19/2010,

PROSECUTION IS HEREBY REOPENED.  New rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed

by an appeal brief under 37 CFR 41.37.  The previously paid notice of appeal fee and

appeal brief fee can be applied to the new appeal.  If, however, the appeal fees set forth

in 37 CFR 41.20 have been increased since they were previously paid, then appellant

must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by

signing below:

/DENNIS-DOON  CHOW/
Supervisory Patent Examiner, Art Unit 2174.


Claim 12 of the pending applicant was never address in the final rejection made

in 12/10/08, therefore, the finality of that action is withdrawn.

Claims 1-20 are pending in this application.  Claims 1, 8, and 20 are independent

claims.

### Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-10, 13, 14, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Gessel US Patent 5,732,213 in view of Chan US Patent

5,027,343.

As per claim 1, Gessel teaches a method of setting up a communication

procedure between instances comprising the steps of:

Selecting the instances that take part in the communication procedure, one

instance being a protocol tester and another instance being an item under test. (see

Gessel; column 3, lines 15-32)

Selecting a protocol layer to be emulated by the protocol tester for testing a

specified protocol layer of the item under test on the basis of the communication

procedure; (see Gessel; column 3, lines 42-58)

Selecting abstract communication interfaces of the emulate protocol layer for the

communication procedure; (see Gessel; column 10, lines 20-32)

Selecting communication data contained in description files to be exchanged at

the abstract communication interfaces; see Gessel; column 3, lines 15-32; col. 7, lines

50-70)

the abstract communication interface selected from a list of abstract

communication interface associated with the select protocol layer(see Gessel; column

3, lines 15-32; col. 7, lines 50-70) and

Automatically setting up through the protocol tester the communication procedure

on the basis of the selection made in the above selecting steps, with parameters for the

abstract communication interface and the communication data selecting steps being

made graphically. (see Gessel; column 6, lines 60-lines 70)

However, Gessel fails to teach the protocol layer selected from a displayed list of

protocol layers that are capable of being emulated by the protocol tester, the list of

protocol layers including at least one layer 2 protocol from an OSL reference mode;

Chan (5,027,343)teaches the protocol layer selected from a displayed list of

protocol layers that are capable of being emulated by the protocol tester, the list of

protocol layers including at least one layer 2 protocol from an OSL reference mode;

(see Chan, col. 3, lines 1-40, col. 4, lines 20-30)

It would have been obvious to an artisan at the time of the invention to include

Chan's teaching with method of Gessel in order to identify and to prevent transmission

errors in the setting of circuits and transmission equipment.


As per claim 2, Gessel and Chan teach the method of claim 1.  Gessel further

teaches the instances selecting step comprises the step of selecting the instances

graphically, (see Gessel, column 11, lines 55-column 12, lines 10) and/or the emulated

protocol layer selecting step comprises the step of selecting the emulated protocol layer

graphically, and the parameters selectable in these steps being assigned description

files that are used in the setting up step. (see Gessel, column 11, lines 55-column 12,

lines 10)

As per claim 3, Gessel and Chan teach the method of claim 1. Gessel further

teaches the abstract communication interfaces comprise Service Access Points (SAPs).

(see Gessel; column 5, lines 35-50)

As per claim 5, Gessel and Chan teach the method of claim 1. Gessel teaches

the communication data selecting step comprises the steps of:

Graphically selecting a data format; and

Graphically setting a communication sequence between the selected instances.

(see Gessel; column 11, lines 35-80)

As per claim 6, Gessel and Chan teach the method of claim 1. Gessel further

teaches the graphically setting up step comprises the step of entering source code. (see

Gessel; Column 7, lines 55-70: Script is a source code)

As per claim 7, Gessel and Chan teach the method of claim 6, Gessel further

teaches all the graphically setting up step comprises the step of entering source code.

(see Gessel, col. 7, lines 54-col. 8, lines 19; Simulation tool that includes test script

software is a setting that allows for entering of source code)

As per claims 8-10 they are the means claims of claims 1-3.

As per claim 13, Gessel teaches the method of claim 8. Gessel further teaches

all parameters selected by all the selecting means are assigned description files that are

used by the setting up means. (see Gessel; Column 7, lines 55-70; Script is a

description files)

As per claim 14, it is rejected under the same rationale as claim 3. Supra.

As per claim 17, it is rejected under the same rationale as claim 3. Supra.

As per claim 19, it is rejected under the same rationale as claim 6. Supra.

As per claim 20, it is rejected under the same rationale as claim 1. Supra.


### *Claim Rejections – 35 USC § 103*

Claims 4, 11, 12 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Gessel US Patent 5,732,213 in view of Chan US Patent 5,027,343 in

view of Matsui US Patent 6,560,723.

As per claim 4, Gessel and Chan teach the method of claim 1.   However, Gessel

fails to teach the communication data comprise at least one type selected from the

group consisting of Protocol Data Units (PDUs) and Abstract Service Primitives (ASP)

Matsuit teaches the communication data comprise at least one type selected

from the group consisting of Protocol Data Units (PDUs) and Abstract Service Primitives

(ASP) (see Matsuit, column 1, lines 55-column 2, lines 10)

It would have been obvious to an artisan at the time of the invention to include

Matsuit's teaching with method of Gessel and Chan in order to create a scenario for use

in a conformation test.

As per claim 11, which is dependent on claim 8, it is rejected under same

rationale as 4. Supra.

As per claim 12, Gessel, Chan, and Matusui teach the method claim 11, Gessel

further teaches all the graphically setting up step comprises the step of entering source

code. (see Gessel, col. 7, lines 54-col. 8, lines 19; Simulation tool that includes test

script software is a setting that allows for entering of source code)

As per claims 15, 16, and 18, they are rejected under the same rationale as claim

4. Supra.

<div align="center">***Response to Arguments***</div>

Applicant's arguments filed 10/19/2009 have been fully considered but they are

not persuasive.

Applicant's argument focused on the following:

A) Whether Gessel teaches additional test parameter –such as a protocol layer,

abstract communication interface, service access points, or communication data- may

be selected from a displayed list?

A) Gessel teaches this limitation because it displays a list of nodes that service

as access points for testing communication protocol layer. (see Gessel, col. 11, lines

35-55)  Therefore, Gessel teaches additional test parameter –such as a protocol layer,

abstract communication interface, service access points, or communication data- may

be selected from a displayed list.

B) Whether Gessel teaches displaying a list of abstract communication interfaces

or service access point interfaces that are associated with selected protocol layer?

B) Gessel teaches limitation because it displays a list of the nodes that service as

service access points for testing communication protocol layer. (see Gessel, col. 11,

lines 35-col. 12, lines 21)  Therefore, Gessel teaches displaying a list of abstract

communication interfaces or service access point interfaces that are associated with

selected protocol layer.

C) Whether it is obvious to combine Gessel and Chan?

C) "Section 103 forbids issuance of a patent when 'the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would

have been obvious at the time the invention was made to a person having ordinary skill in the art

to which said subject matter pertains.'" *KSR Int'l Co. v.Teleflex Inc.,* 127 S. Ct. 1727, 1734

(2007).

In *KSR,* the Supreme Court emphasized "the need for caution in granting a patent based

on the combination of elements found in the prior *art,"Id,* at 1739, and discussed circumstances

in which a patent might be determined to be obvious. *KSR,* 127 S. Ct. at 1739 (citing *Graham v.*

*John Deere Co.,* 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent

that "[t]he combination of familiar elements according to known methods is likely to be obvious

when it does no more than yield predictable results." *Id.* The operative question in this

"functional approach" is thus "whether the improvement is more than the predictable use of prior

art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the

result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the

common sense of those skilled in the art demonstrates why some combinations would have been

obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.,* 485 F.3d 1157,

1161 (Fed. Cir. 2007) (citing *KSR,* 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in

part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the

combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or

"represented an unobvious step over the prior art." *Id.* (citing *KSR,*127 S. Ct. at 1740-41).

In the present case, the combination of Gessel and Chan is obvious to one of

ordinary skilled in the art because its provide user with ability to identify and to prevent

transmission errors in the first two layers of circuits and transmission equipments while

configuring the network protocol.

### *Contact Information*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to SIMON KE whose telephone number is (571)272-4062.

The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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